

**THIS OPINION WAS NOT WRITTEN FOR PUBLICATION**

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 12

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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***Ex parte*** GEORGE H. HINKENS

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Appeal No. 98-0585  
Application No. 08/638,526<sup>1</sup>

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ON BRIEF

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Before MEISTER, ABRAMS and NASE, ***Administrative Patent Judges.***

MEISTER, ***Administrative Patent Judge.***

**DECISION ON APPEAL**

George H. Hinkens (the appellant) appeals from the final rejection of claims 1-4. Claim 5, the only other claim present in the application, as been indicated as being

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<sup>1</sup> Application for patent filed April 26, 1996.

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allowable subject to the requirement that it be rewritten to include the subject matter of parent claim 4.<sup>2</sup>

We AFFIRM.

The appellant's invention pertains to a disk brake assembly.

Independent claim 1 is further illustrative of the appealed subject matter and a copy thereof may be found in the attachment to the brief styled "CLAIMS ON APPEAL."

The reference relied on by the examiner is:

Japanese patent (Sakazume)<sup>3</sup>      61-31733      Feb. 14, 1986

Claims 1-4 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Sakazume.

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<sup>2</sup> The examiner first indicated that claim 5 contained allowable subject matter in the answer. In response to the answer the appellant filed a reply brief which (1) stated that "[c]laim 4 has been amended to include claim 5 and is now in condition for allowance" (see page 1) and (2) had attached thereto a copy of claim 4 in rewritten form under the heading "CLAIM ALLOWED." The appellant, however, has submitted no formal amendment which amends claim 4 and cancels claim 5, and the examiner has simply stated that the reply brief was entered (see Paper No. 10). The appellant should submit such a formal amendment within two months of the date of this decision.

<sup>3</sup> Translation attached.

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The rejection is explained on pages 2 and 3 of the final rejection. The arguments of the appellant and examiner in support of their respective positions may be found on pages 4-6 of the brief, pages 1 and 2 of the reply brief, and pages 4 and 5 of the answer.

#### **OPINION**

At the outset, we note that the appellant on page 4 of the brief states that the rejected claims stand or fall together. Accordingly, claims 1-4 will stand or fall with representative claim 1. 37 CFR § 1.192(c)(7).

We have carefully reviewed the appellant's invention as described in the specification, the appealed claims, the prior art applied by the examiner and the respective positions advanced by the appellant in the brief and the reply brief and by the examiner in the answer. As a consequence of this review, we will sustain the above-noted rejection.

With respect to representative claim 1 the final rejection states that

Sakazume discloses all the features of the applicant's invention such as a disk brake assembly comprising a rotary disk 1, a caliper having side

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wall sections 2a,2b located on both sides of the disk 1, a brake pad 7, a cylinder 4,4 provided on each of said side wall sections 2a,2b, piston 5 slidably mounted in each of said cylinders 4,4 including a first bore 13 having a diameter greater than the diameter of the piston 5, and a flange (note from figure 3 of Sakazume that portion of the cylinder between element numerals 14 and 16 is readable as being the flange) having a diameter corresponding to but slightly greater than the diameter of the piston for slidably supporting the piston 5 in the cylinder 4. [Page 2.]

The appellant, however, argues that the purpose of Sakazume's arrangement is to avoid any variation in the relative positions between the cylinders and the pistons if a disk is deformed by heat whereas in the claimed bore and flange arrangement the piston is free to pivot about the flange.

We are unpersuaded by the appellant's arguments. The terminology in a pending application's claims is to be given its broadest reasonable interpretation (*In re Morris*, 127 F.3d 1048, 1056, 44 USPQ2d 1023, 1028 (Fed. Cir. 1997) and *In re Zletz*, 893 F.2d 319, 321, 13 USPQ2d, 1320, 1322 (Fed. Cir. 1989)) and limitations from a pending application's specification will not be read into the claims (*Sjolund v. Musland*, 847 F.2d 1573, 1581-82, 6 USPQ2d 2020, 2027 (Fed.

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Cir. 1989)). Moreover, anticipation by a prior art reference does not require either the inventive concept of the claimed subject matter or the recognition of inherent properties that may be possessed by the prior art reference. **See Verdegaal Bros., Inc. v. Union Oil Co.**, 814 F.2d 628, 633, 2 USPQ2d 1051, 1054 (Fed. Cir. 1987). A prior art reference anticipates the subject matter of a claim when that reference discloses every feature of the claimed invention, either explicitly or inherently (**see In re Schreiber**, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997) and **Hazani v. Int'l Trade Comm'n**, 126 F.3d 1473, 1477, 44 USPQ2d 1358, 1361 (Fed. Cir. 1997)); however, the law of anticipation does not require that the reference teach what the appellant is claiming, but only that the claims on appeal "read on" something disclosed in the reference (**see Kalman v. Kimberly-Clark Corp.**, 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983)).

Here, representative claim 1 broadly sets forth that the cylinders have a first bore "having a diameter greater than the diameter of the piston" and a flange "having a diameter

corresponding to but slightly greater than the diameter of the piston for slidably supporting said piston." As the examiner has correctly noted, these recitations "read on" the arrangement illustrated in Fig. 3 of Sakazume wherein the first bore is the groove 13 and the flange is that portion of the cylinder wall which is between seal 14 and the wiper seal 16. We also observe that the above-noted limitations are readable on the structure of Sakazume's Fig. 3 wherein the left-hand portion of cylinder wall is the bore (which is clearly depicted as having a greater diameter than the remainder of the cylinder wall) and the remainder of the cylinder wall (i.e., the right-hand portion) is the flange. In fact, the terminology of representative claim 1 is so broad that the bore and flange could even be of the same diameter (e.g., wherein both the bore and flange have a diameter that is "slightly greater" than the diameter of the piston).

As to the appellant's contention that the claimed bore and flange arrangement allows the piston to pivot about the flange, this argument is simply not commensurate in scope with the claimed subject matter inasmuch as no pivoting movement has been claimed. It is well settled that features not

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claimed may not be relied upon in support of patentability.

***In re Self***, 671 F.2d 1344, 1348, 213 USPQ 1, 5 (CCPA 1982).

In view of the foregoing, will sustain the rejection of claims 1-4 under 35 U.S.C. § 102(b) as being anticipated by Sakazume.

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No time period for taking any subsequent action in  
connection with this appeal may be extended under 37 CFR  
§ 1.136(a).

***AFFIRMED***

JAMES M. MEISTER	)	
Administrative Patent Judge	)	
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	)	
	)	
	)	BOARD OF PATENT
NEAL E. ABRAMS	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
	)	
	)	
JEFFREY V. NASE	)	
Administrative Patent Judge	)	

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